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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,783	11/28/2001	Francois Girard	P21643	8368
7055	7590	02/23/2004		
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER STASHICK, ANTHONY D	
			ART UNIT 3728	PAPER NUMBER 13
DATE MAILED: 02/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/994,783

Applicant(s)

GIRARD ET AL.

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 25-30, 32, 33 and 36-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-17, 19-24, 31, 34-35, 39-41, 43-48 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 18, 42 and 49-59 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Since applicant's petition has been granted and applicant has filed a response to the first Office action, the following Office action on the merits will be directed to claims 1-24, 31, 34-35 and 39 along with newly added claims 40-59.
2. Claims 25-30, 32, 33 and 36-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

***Specification***

3. The amendment filed November 26, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the phrase "the elements can be regarded more generally as tread member.". This was not present in the application as originally filed and does not have support from the originally filed application. Applicant admits as much in the amendment on page 17, under A. Withdrawal of the Objection

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to the Specification, paragraph 2. Applicant is adding proper antecedent basis for claims 51 and 52 by adding new matter located in these claims into the specification rather than these claims already having proper support from the originally filed application. Applicant is required to cancel the new matter in the reply to this Office Action.

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-24 and 49-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the phrase "preferably, by cementing and/or riveting and/or welding." which renders the claim vague and indefinite. It is unclear what the metes and bounds of the claim is since it cannot be determined whether the applicant is using all three fastening means, a combination of two of the three fastening means, or just one of the fastening means. Claim 5 contains the phrase "the junction/overlapping zone" in line 1 of the claim

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that renders the clam vague and indefinite. There is insufficient antecedent basis for this limitation in the claim. Claim 8 contains similar language to claim 1 without the term "preferably", but the same argument is applied here as it is indeterminable what fastening means or combination thereof that applicant is intending to claim. Claim 12 contains the phrase "(preferably front)" in line 2 of the claim which renders the claim vague and indefinite. It is not clear whether the applicant is claiming the front half sole or the rear half sole in this section of the claim. Also, in the fourth line of the claim the language "having appropriate mechanical qualities for rigidity..." renders the claim vague and indefinite because it is not clear what the term "appropriate" is meant to encompass. Claim 49 contains the phrase "said one reinforcement structure" twice in lines 7-9 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 5-11, 14-17, 20-24, 31, 34-35, 39-41, 43-46 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by the Great Britain references to Sportartlkekfabrik Karl Uhl GmbH GB 2,256,784 (GB '784). GB '784 discloses all the limitations of the claims including the following: a front portion 71a and a rear portion 71b more rigid in longitudinal bending than the front portion (page 12, line 19-page 13, line 10); at least one reinforcement in said two portions 63; the front portion comprises a front half-sole 71a affixed to the reinforcement 63; the rear portion comprises a rear half-sole 71b affixed to the reinforcement 63; the front and rear half-soles are assembled to one another in a junction zone 72 by cementing or riveting or welding; the limit between the flexible front portion and the rigid rear portion is located substantially at the rear of the metatarsophalangeal bending zone (See Figure 2); the junction zone is located in and/or behind the so-called metatarsophalangeal bending zone (see Figure 2); wherein a reinforcement member has at least one laminated plate 72 extending from the junction zone on both the front and rear half-soles; the reinforcement member has a length at least 60% (60%-80%) of the length of the sole (see Figure 2); at least one

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of the front or rear portions having a construction designed to cooperate with a sports apparatus (the cleat of the shoe); at least one of the front or rear half soles is constituted by at least one piece for guiding and for connecting to a sports shoe apparatus (the receiver for the spike); the sole has, on its lower surface in the front or rear portion at least one guiding member (receiver for spike) adapted to cooperate (threaded) with complementarily shaped guiding support (the threaded stem of the spike) provided on the sports apparatus (the spike); the sole being adapted to be coupled to the sports apparatus (screw in the spike into the receiver); the reinforcement member is assembled to the front and rear portion of the sole by cementing; the reinforcement member is made of a composite (thermoplastic material); the reinforcement member has a sandwich structure (from side-to-side rather than top to bottom); the sandwich structure has a thickness less than 3 mm (see Figures 2-6); the reinforcement member is a plate covered with at least one compatibility layer (thin layer of rubber, see 73 in Figure 4) made by of at least one synthetic film; in the rear portion the reinforcement member has one or several upward extensions 65 and is associated with at least one other reinforcement; the rear portion forms an integral assembly with a stiffener (63) covering the heel; the rear portion having a

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different rigidity than the stiffener (different material); the portions are made of different materials; the sole is an outer sole (see Figures); the sole having at least one recess (that through 65) that shows a portion of the reinforcement; the shoe is a sports boot (see page 12, line 19); the sports boot is adapted to be affixed on a sports apparatus (spikes); the sole having a plate 63 to reinforce the sole and corresponding to a planar projection of a human foot (see Figure 1); an upper attached to the sole (see Figure 1).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 46-47 are rejected under 35 U.S.C. 103 (a) as being unpatentable over the Great Britain references to Sportartlkekfabrik Karl Uhl GmbH GB 2,256,784 (GB '784) as applied to claim 43 above in view of Official Notice. The methods of attachment claimed in these claims are well known in



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the art of shoemaking and appear to be an art accepted equivalent way of attaching the soles together. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to attach the sole together by any means known in the art to hold the sole together.

10. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,256,784 as applied to claim 1 above in view of Montgomery et al. 4,924,606. GB '784 discloses all the limitations substantially as claimed except for the front and rear portions overlapping in the junction zone. Montgomery et al. '606 teaches that a two part sole can overlap each other when connected together to allow for increasing flexibility of the shoe in this region as well as allow for adaptability to many different sizes. Therefore, it would have been obvious, in view of Montgomery et al. '606, to make the front and rear portions of the sole of GB '784 overlap in the junction zone to allow for better flexibility of the sole and adjustability of the sole to shoes of different sizes.

***Allowable Subject Matter***

11. Claims 12, 13, 18 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten

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to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 49-59 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

13. Applicant's arguments filed November 26, 2003 have been fully considered but they are not persuasive. Applicant argues that the GB'784 reference was cited on the European search report and found to be "pertinent to the general background of the invention". and therefore not identified as being particularly pertinent. This argument is not clearly understood. This reference was found by the examiner to be pertinent to the instant application and thoroughly discussed herein. Applicant argues that GB '784 is two separate plates embedded in a rubber frame and that the rubber frame would be too weak to be fairly characterized as a reinforcement. This argument is not clearly understood. If the rubber frame was not present, the two plates could separate and therefore, with the

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rubber frame present, this separation does not occur, thereby reinforcing the plates as it aids in holding them in position. Applicant supports this by arguing that "If one were to remove the frame, there would be no more sole...". Applicant further argues that the reinforcing plate 67 is only located in the heel and therefore "this reinforcement cannot be said to be linked to the front part of the sole...". This argument is not clearly understood as the heel and front portions of the sole are linked together at the junction, the reinforcement 67 would then have to be "linked" to the front portion as well. With respect to applicant's argument that one would not have deconstructed the sole of GB'784 and made it of two parts as taught by Montgomery, this argument is not clearly understood. Montgomery teaches that the sole can be made in two parts placed together to act as one and therefore, this teaches that the sole of GB '784 can be made of two parts placed together to act as one.

### *Conclusion*

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

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If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>

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A handwritten signature in black ink, appearing to read "Anthony Stashick". The signature is fluid and cursive, with the first name "Anthony" and last name "Stashick" clearly distinguishable.

Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS

February 23, 2004